

UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: SOROTZKIN, Michael :

Application No.: 09/894,966 :

Filed: June 28, 2001 :

Title of Invention: *System and method for confirming specification of intended electronic mail message recipients*Kalow & Springut LLP
488 Madison Avenue, 19th floor
New York, NY 10022

September 16, 2009

Mail Stop PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**RENEWED PETITION UNDER 37 CFR 1.137(b)**

In response to the Decision on Petition mailed on August 3, 2009, Applicant hereby requests reconsideration of the Petitions Examiner's dismissal of the petition filed on April 28, 2009. Based on the arguments provided below and the accompanying declarations of inventor Michael Sorotzkin and attorney Fred P. Schwartz, Applicant requests that the late filing of the issue fee be accepted.

SUMMARY

Petitioner Michael Sortozkin is a resident of Israel, solo inventor and applicant, whose patent application in the above-captioned matter was allowed in 2005. Unfortunately, he never received the Notice of Allowance or a subsequent Notice of Abandonment and the patent application became abandoned. Being unfamiliar with U.S. Patent Practice, he did not know that he should expect a Notice of Allowance prior to obtaining an issued patent. Indeed, until a few months ago he believed that his patent rights were in force.

As described more fully below, as soon as Petitioner learned of the abandonment, he promptly retained new patent counsel to investigate why he had not received either the Notice of Allowance or the Notice of Abandonment, and on April 28, 2009 caused a Petition to Revive an Unintentionally Abandoned Application to be filed. As the Patent Office has recommended to other Applicants who did not receive a PTO communication, Mr. Sorotzkin filed the April 28th petition because absent knowledge that a Notice of Allowance issued or that any action was due, he could not have had the intent to abandon his application. See *In re Lesch*, Applic. Ser. No. 10/603,235, 2009 Commr. Pat. LEXIS 42 22 (May 20, 2009) (a petitioner who unintentionally did not timely submit an issue fee due because of non-receipt of Notice of Allowance should file petition under 37 CFR 1.137(b) for unintentional abandonment); *In re Ching-Ming Chang*, Applic. Ser. No. 10/033,472, 2007 Commr. Pat. LEXIS 1 *10-11 (Feb. 23, 2007) (showing of non-receipt of Office Action may be used to show unintentional delay in filing a response).

ARGUMENT

Pursuant to 37 CFR 1.137(b), upon submission of a petition to revive, a patent application may be revived if the delay in responding was unintentional. The requirements for a grantable petition are that the petition must be accompanied by:

- (1) The reply required to the outstanding office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. . . . and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

37 CFR 1.137(b). “The Director may require additional information where there is a question whether the delay was unintentional.” 37 CFR 1.137(b)(3).

On April 28, 2009, Applicant filed a petition to revive an unintentionally abandoned patent application, which was abandoned due to a failure to pay the issue fee. In response, on August 3, 2009, the Patent Office dismissed the petition and required that additional information be submitted to show that: “(1) the delay in reply that originally resulted in the abandonment; [and] (2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the grantable petition” were unintentional. For the reasons described below and through the evidence presented within the accompanying declarations of inventor Michael Sorotzkin and attorney Fred P. Schwartz, Esq., Applicant hereby renews his petition to revive.

First, as the accompanying declaration demonstrates, the delay in filing the reply that resulted in abandonment was unintentional. As Mr. Sorotzkin describes, neither he nor any of the law firms with which his previous attorney was affiliated during the relevant time period have any record of receiving the Notice of Allowance, the Corrected Notice of Allowance or the Notice of Abandonment. Because Mr. Sorotzkin never received either of these documents, he could not have formed an intent not to respond to them or an intent to abandon his application.

The Patent Office issued the Notice of Allowance on June 7, 2005, which as the Patent Office records show, was returned to the Patent Office on June 12, 2005. (Sorotzkin ¶¶ 10 -11, Exhs. D & E) The Patent Office then issued a Corrected Notice of Allowance on December 9, 2005 and a Notice of Abandonment on May 4, 2006, which it mailed to Erik B. Cherdak at Arent Fox. (Sorotzkin ¶¶ 12-13, Exhs. F&G) However, Mr. Sorotzkin was never informed that Arent Fox received this Corrected Notice of Allowance or the Notice of Abandonment. (Sorotzkin ¶ 14)

Arent Fox recently informed Mr. Sorotzkin's current patent counsel that on October 3, 2005 his file was transferred to Mr. Cherdak at the law firm of Duane Morris, and that they have no documents pertaining to this matter. (Sorotzkin ¶ 20, Exh. I) This is two months prior to the issuance of the Corrected Notice of Allowance, and seven months prior to the mailing of the Notice of Abandonment.

Mr. Sorotzkin, through his current attorneys, also contacted the law firm of Duane Morris in order to ascertain what happened. Duane Morris represented that they have reviewed their records, and they also have no files pertaining to this matter or to any matter for Mr. Sorotzkin. (Sorotzkin ¶ 21 Exh. J) Thus, neither firm has any record of receiving these communications or reporting these communications to Mr. Sorotzkin.

A review of the Patent Office's records on August 11, 2009 lists Mr. Cherdak as being employed by Burns & Levinson LLP. Mr. Sorotzkin's current attorneys contacted Burns & Levinson LLP. On April 13, 2009, Burns & Levinson LLP indicated that Mr. Cherdak did not join their firm until July 31, 2006, that Mr. Cherdak left their employ as of March 1, 2007, and that they have no record of this matter in their docketing system. (Sorotzkin ¶¶ 22-23, Exhs. K&L)

Finally, Mr. Sorotzkin, through his present attorneys tried to contact Mr. Cherdak directly at his last known home address as provided by Burns & Levinson in order to determine whether he has any record of receiving the Corrected Notice of Allowance. (Sorotzkin ¶ 24, Exh. M) However, no response has been received. (Sorotzkin ¶ 25)

Based on the foregoing, it is clear that there is no record of Mr. Sorotzkin or his former patent attorney (or the law firm with which that attorney was practicing) having ever received the Corrected Notice of Allowance or the Notice of Abandonment, let alone having brought them to Mr. Sorotzkin's attention. Mr. Sorotzkin, confirms this fact in his declaration. (Sorotzkin ¶ 14) Further, Mr. Schwartz, Mr. Sorotzkin's attorney for non-patent matters, confirms that he too did not receive these documents. (Schwartz ¶¶ 6-7) Because Mr. Sorotzkin did not receive the Corrected Notice of Allowance, by definition he could not have intentionally declined to pay it.

Moreover, the delay in paying the issue fee was not intentional because until 2009, Mr. Sorotzkin believed that Mr. Cherdak had taken all steps necessary to perfect Mr. Sorotzkin's patent rights. (Sorotzkin ¶ 17) This belief is corroborated by the fact that as late as April 28, 2006, which was after the date on which, unbeknownst to Mr. Sorotzkin, his patent application had become abandoned, Mr. Cherdak was still reporting to Mr. Sorotzkin about a deadline for foreign patent applications. (Sorotzkin ¶ 15 Exh. H) Thus, until February 2009, Mr. Sorotzkin, who did not know

that a Notice of Allowance would issue and an issue fee would come due prior to the issuance of his United States patent, was understandably under the belief that his patent rights were perfected in the United States. (Sorotzkin ¶ 17) Accordingly, during the time between when the issue fee was due and February 2009, Mr. Sorotzkin could not have intentionally abandoned the application, because he believed that he had already been granted a United States patent. Similarly, Mr. Sorotzkin could not have intentionally declined to act in response to the Notice of Abandonment because he had not received it.

In the dismissal of the petition, the Petitions Attorney indicated that any renewed petition must clearly identify the party having the right to reply. This party was Michael Sorotzkin, who would sometimes communicate directly with his former patent attorney and sometimes communicate with his former patent attorney through his other attorney Fred P. Schwartz. (Sorotzkin ¶ 4) Neither of Mr. Sorotzkin's attorneys had full decision-making authority. (Sorotzkin ¶ 3)

The Petitions Attorney also requested an explanation as to any efforts to reply to the outstanding office action. The outstanding office action was a Notice of Allowance and request for payment of the issue fee. As described above, no response was filed until 2009, because prior to that time Mr. Sorotzkin was unaware that the Corrected Notice of Allowance has issued, or that he should have expected one to issue in order to perfect his rights. (Sorotzkin ¶ 14)

Finally, the Petitions Attorney asked for an explanation from Mr. Cherdak as to why the application became abandoned under Arent Fox's control. Mr. Sorotzkin tried to obtain the same explanation, but he has been unable to locate Mr. Cherdak, and Arent Fox has represented that it transferred all files to another law firm on October 3, 2005, two months prior to the issuance of the Corrected Notice of Allowance and that it has no documents pertaining to this matter. (Sorotzkin ¶

20, Exh. I) Thus, Mr. Sorotzkin cannot determine when or whether Arent Fox or Mr. Cherdak received or became aware of either the Corrected Notice of Allowance or the Notice of Abandonment.

Second, the time period between when Mr. Sorotzkin learned of the abandonment —February 2009 — and when he filed the petition to revive — April 2009 — was only as long as it was necessary to retain new patent counsel and to investigate the underlying facts in order to determine if there were any record of Mr. Cherdak, or any of the law firms for which Mr. Cherdak worked, having received a Corrected Notice of Allowance. None of these law firms has any record of receiving the Corrected Notice of Allowance or Notice of Abandonment. (Sorotzkin ¶¶ 18-23, Exhs. I-L) Further, Mr. Sorotzkin's U.S. attorney on other matters confirms that he has no record of ever having received a notification of the receipt by Mr. Cherdak or anyone else of the Corrected Notice of Allowance or the Notice of Abandonment. (Schwartz ¶¶ 6-7)

The Petitions Attorney emphasized that the entire delay must have been unintentional. Applicant's delay was three years and one month from the date of abandonment, and only two months from learning of the abandonment. Moreover and as noted above, the brief two-month period was required for Applicant to make a good-faith effort to determine whether his prior attorney and any of the law firms with which he had been associated had any records to explain why he never received either the Notice of Abandonment or the Corrected Notice of Allowance.

CONCLUSION

Mr. Sorotzkin, an Israeli resident, had since the time that he filed his patent application intended to pursue it to issuance. Until earlier this year, he believed, albeit incorrectly, that his

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patent had in fact issued and was in force. He was never notified of the issuance of a Corrected Notice of Allowance and did not know that one was a prerequisite to the perfecting his patent rights. Similarly he never received a Notice of Abandonment. Accordingly, he could not have intended to allow his application to become abandoned. Confirming his position are his sworn statements, the fact that his former patent attorney has disappeared, and the fact that none of the law firms at which that attorney previously worked has a record of receiving the aforementioned communications. Based on these facts and the accompanying declarations, Mr. Sorotzkin requests that his application be revived.

Respectfully Submitted,

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